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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,578	07/09/2003	Seiji Kato	1003-1-01 PUS	1326

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EXAMINER

PARSLEY, DAVID J

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/616,578

Applicant(s)

KATO, SEIJI

Examiner

David J Parsley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **Detailed Action**

### ***Amendment***

1. This office action is in response to applicant's amendment dated 6-19-04 and this action is final.

### ***Specification***

2. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

### ***Claim Objections***

3. Claim 9 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 8. When two claims in an application are duplicates or else are so close in content that they both

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cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-9 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by JP Patent No. 10-262501.

Referring to claims 1 and 11, the Japanese patent discloses a fishing lure comprising, a lure body – at 31-32 or 41-42, comprising a rigid portion – at 35,37,38-40 or 45, 47, 50, and a resilient portion – at 32 or 42, wherein the resilient cover portion houses the rigid portion – see figures 3-4, and wherein the rigid portion comprises at least two separate components positioned at opposite ends of the elongated lure body – see figures 3-4, and the resilient portion housing the at least first and second rigid portions – see for example figures 3-4, connected by an elastic component – at 33 or 43, for allowing the lure body to flex, wherein the elastic component is made of a memory alloy – see the English abstract, to maintain a particular shape although flexible enough to bend in various directions – see for example the English abstract and figures 3-4.

Referring to claims 2 and 13, the Japanese patent discloses a fishing line attachment – at 36 or 46, attached to one of the at least two separate components for allowing a fishing line to be connected to the lure body – see for example figures 3-4.

Referring to claims 3 and 14, the Japanese patent discloses a hook attachment component – at 38,39 or proximate 50, attached to one of the at least two separate components for allowing a hook to be connected to the lure body – see for example figures 3-4.

Referring to claim 4, the Japanese patent discloses the lure body is an elongated body with one of each of the at least two separate components positioned at the elongated body's opposite ends – see for example figures 3-4.

Referring to claim 5, the Japanese patent discloses the at least two separate components have a composition strength that can withstand forces associated with fishing without breaking – see for example figures 3-4.

Referring to claim 6, the Japanese patent discloses the elastic component – at 33 or 43 is a wire – see the English abstract, having a composition strength that can withstand forces associated with fishing and repetitive bending without breaking – see for example the English abstract and figures 3-4.

Referring to claims 8-9 and 12, the Japanese patent discloses the elastic component has a biasing property for allowing the lure body to bend approximately 30 degrees to imitate body positions of live bait when moving – see for example the English abstract and proximate 33 or 43 in figures 3-4.

Referring to claim 15, the Japanese patent discloses the at least first and second rigid components and the elastic component have a composition strength the can withstand forces

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associated with fishing and repetitive bending without breaking – see for example figures 3-4 and the English abstract.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent as applied to claim 1 above, and further in view of U.S. Patent No. 5,182,875 to Righetti.

Referring to claim 7, the Japanese patent does not disclose the elastic component is blade-shaped. Righetti does disclose the elastic component – at 900, is blade-shaped – see for example figure 11. Therefore it would have been obvious to one of ordinary skill in the art to take the device of the Japanese patent and add the elastic component being blade-shaped of Righetti, so as to increase the flexibility of the lure so that it mimics the movements of fish.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent as applied to claim 1 above, and further in view of U.S. Patent No. 5,203,103 to Hawley. The Japanese patent in the English abstract does not disclose the soft portion is plastic. Hawley does disclose the soft portion – at 10, is plastic – see for example column 2 lines 20-32.

Therefore it would have been obvious to one of ordinary skill in the art to take the device of the

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Japanese patent and add the soft portion made of plastic of Hawley, so as to make the lure flexible and more lightweight.

Claims 17-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent in view of Hawley.

Referring to claim 17, the Japanese patent discloses a fishing lure comprising, a lure body – at 31-32 or 41-42, comprising a rigid portion – at 35,37,38-40 or 45, 47, 50, and a resilient portion – at 32 or 42, wherein the resilient cover portion houses the rigid portion – see figures 3-4, and wherein the rigid portion comprises at least two separate components positioned at opposite ends of the elongated lure body – see figures 3-4, and the resilient portion housing the at least first and second rigid portions – see for example figures 3-4, connected by an elastic component – at 33 or 43, for allowing the lure body to flex, wherein the elastic component is made of a memory alloy – see the English abstract, to maintain a particular shape although flexible enough to bend in various directions – see for example the English abstract and figures 3-4. The Japanese patent in the English abstract does not disclose the soft portion is plastic. Hawley does disclose the soft portion – at 10, is plastic – see for example column 2 lines 20-32. Therefore it would have been obvious to one of ordinary skill in the art to take the device of the Japanese patent and add the soft portion made of plastic of Hawley, so as to make the lure flexible and more lightweight.

Referring to claim 18, the Japanese patent as modified by Hawley further discloses the elastic component – at 33 or 43 is a wire – see the English abstract of the Japanese patent, having a composition strength that can withstand forces associated with fishing and repetitive bending without breaking – see for example the English abstract and figures 3-4 of the Japanese patent.

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Referring to claim 20, the Japanese patent as modified by Hawley further discloses a hook attachment component – at 38,39 or proximate 50, attached to one of the at least two rigid components for allowing a hook to be connected to the lure body – see for example figures 3-4 of the Japanese patent.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent as modified by Hawley as applied to claim 17 above, and further in view of U.S. Patent No. 5,182,875 to Righetti.

Referring to claim 19, the Japanese patent as modified by Hawley does not disclose the elastic component is blade-shaped. Righetti does disclose the elastic component – at 900, is blade-shaped – see for example figure 11. Therefore it would have been obvious to one of ordinary skill in the art to take the device of the Japanese patent as modified by Hawley and add the elastic component being blade-shaped of Righetti, so as to increase the flexibility of the lure so that it mimics the movements of fish.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-15 and 17-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***



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7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to fishing lures comprising shape memory alloys:

U.S. Pat. No. 4,625,446 to Morimoto – shows lure with resilient portion

U.S. Pat. No. 6,453,599 to Mathews et al. – shows lure with memory alloy

JP Pat. No. 2002-136247 – shows lure with memory alloy wire

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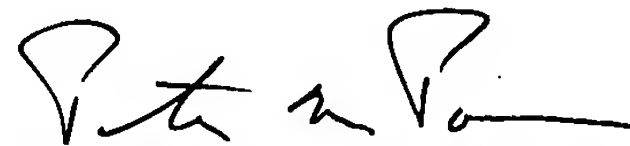
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J Parsley whose telephone number is (703) 306-0552. The examiner can normally be reached on 9hr compressed.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Parsley  
Patent Examiner  
Art Unit 3643



**PETER M. POON**  
**SUPERVISORY PATENT EXAMINER**

8/27/07